



Paper No. 7

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OFFICE OF PETITIONS

In re Application of
Wyzgala, et al.
Application No.: 09/629,771
Filed: July 31, 2000
Attorney Docket No.: BSCO114052
For: EXPANDABLE ABLATION BURR

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: DECISION REFUSING STATUS
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: UNDER 37 CFR 1.47(a)
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This is a decision on the petition under 37 CFR 1.47(a), filed March 27, 2001.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on July 31, 2000 without an executed oath or declaration. Accordingly, on September 25, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and filing fees, and a surcharge for their late filing.

In response, on March 27, 2001 (certificate of mailing date March 23, 2001), a petition for a four month extension of time and required fee, a declaration executed by 8 of 9 joint inventors, the surcharge, application filing fees, the petition fee, and the instant petition were filed. A declaration of facts of Susan L Creek, a patent legal secretary, accompanied the petition. Ms. Creek explains that non-signing joint inventor Eric B. Hamilton received a copy of the declaration for the above-identified application, but did not respond to the request that he sign the declaration for the patent application.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1), (2), and (4) above.

As to item (1), Applicant has failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims,

drawings, if any, and a declaration. See MPEP 409.03(d). Ms. Creek's statement of facts does not establish that a complete copy of the application was mailed to Mr. Hamilton's last known address.

Mr. Hamilton must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. When petitioner can show that Mr. Hamilton was mailed or received the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration, petitioner will have satisfied this requirement.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration contains an noninitialed, nondated alteration to Inventor Hiblar's name. 37 CFR 1.52(c) states that "[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of the accompanying oath or declaration pursuant to 1.63...." This includes the oath or declaration. The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a). An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of Mr. Hamilton is REQUIRED. See MPEP 409.03(a).

It is noted that the address for Mr. Hamilton on the declaration is not one of the addresses to which Ms. Creek sent the copies of the declaration and the reminder letters. The Office would like a statement from petitioner, that the address on the declaration for Mr. Hamilton was indeed a prior address for him.

As to item (4), a clear statement of the inventor's last known address is missing and is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (703) 308-6712.



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for Patent Examination Policy